UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,045	06/14/2001	Kyoko Kimpara	Q64919	5944

7590 01/18/2007 SUGHRUE, MION, ZINN, MACPEAK & SEAS 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3202	**EXAMINER** BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-7 and 9* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-7 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.
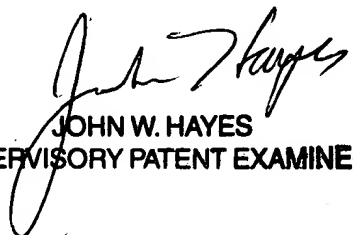
DETAILED ACTION

In view of the Pre-Brief Conference request filed on 09/28/06, PROSECUTION IS

HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed

by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and

appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth

in 37 CFR 41.20 have been increased since they were previously paid, then appellant

must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by

signing below:

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Response to Amendment

Amendment received on 09/28/06 is acknowledged and entered. Claims 1, 2, and 8 have been canceled. Claim 9 has been amended. Claims 3-7 and 9 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claims 3-7 and 9 include the following limitation which was not described in the specification: "a *non-programmed*" conversion instructing banner".

The specification does not include the term "*non-programmed*". Page 17 of the specification defines the conversion instructing banner as following:

"the translation implementing request information I60 is transmitted to the translation server 70 by clicking the translation instructing banner 61 *which is a specifying image area, icon or a like on a monitor screen* linked to a translation instructing program (Step S6, translation request processing)."

There is not indication in the specification that said banner *is not* a programmed object, a command, a programmed sequence of instructions or Java applet. Furthermore, the specification states that said banner is an icon or an equivalent of the

icon. Furthermore, it is well-know in the art that icons represents application programs.

For example, Franco et al. (US 6,687,745 B1) teaches that:

"each application program available on a computer may be represented as an "icon" on the desktop, and each application program running on the computer may be represented as one or more electronic "sheets" displayed in regions of the monitor referred to as "windows" (C. 1, L. 49-56).

Moreover, Segan et al. (US 7,054,928 B2) discloses character icons:

"To perform a function ..., a user will simply select a particular enhancement icon ... whereupon the application or program associated with the selected enhancement icon will be executed to perform the corresponding icon function" (C. 5, L. 12-17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furst (US 6,297,819) in view of Yates et al. (US 6,330,586).

Claims 3, 6 and 9.

Furst teaches a system, method and a computer-readable medium containing

instructions for translating a Web-page from its native language into a desired language,

said system comprising a contents server; a user terminal; and a conversion server,

said method comprising:

contents providing processing in which said contents provider terminal provides

said contents server with contents (Fig. 1, item 140; C. 5, L. 29) in which a non-

programmed translation instructing banner (Fig. 1, item 116; C. 4, L. 40-41) including

conversion implementing request information is arranged (C. 11, L. 65-67);

contents provider information registering processing in which said contents

provider terminal (database server 149; Fig. 1; C. 6, L. 52-55) provides said conversion

server (Fig. 1; item 130) with contents provider information including contents

information and subscription-related information (subscription window, C. 10, L. 26-28)

such that said contents provider information is registered on said conversion server (C.

6, L. 54 - C. 7, L. 7);

contents storing processing in which said contents server stores said contents

provided by a contents provider (C. 11, L. 65-68);

contents transmitting processing in which said contents server transmits said

stored contents to said conversion server by request of said conversion server (C. 11, L.

65 - C. 12, L. 3);

contents displaying processing in which said user terminal selects and displays

said contents stored in said contents server (web browser which displays information

from data base server 140, C. 5, L. 29; C. 11, L. 65-68, Fig. 1, item 112);

conversion request processing (translation application, C. 11, L. 65-68), in which

said user terminal transmits conversion implementing request information used to make

a request of said conversion server for the displayed contents in accordance with an

instruction (subscription window) through said translation instructing banner (C. 10, L.

26-28);

converting processing in which said conversion server (Fig. 1; item 130) refers to

said contents registered database (Fig. 1; item 140; C. 5, L. 29), and then acquires said

contents from said contents server and converts the acquired contents (translation

application, C. 11, L. 65-68) based on said conversion implementing request information

received from said user terminal, and registers information that said conversion has

been performed as use history information on a storing device (C. 7, L. 6);

conversion result transmitting processing in which said conversion server

transmits said results of conversion of said contents to said user terminal (C. 11, L. 65-

68);

conversion result displaying processing in which said user terminal inputs

results of conversion of said contents from said conversion server and displays the

input results of conversion of said contents (C. 11, L. 65-68);

subscription-related information transmitting processing in which said conversion

server produces subscription-related information based on the registered contents

provider information stored in said contents registered database and transmits said

subscription-related information produced to said contents provider terminal

(subscription window, C. 10, L. 26-28; Fig. 1, item 140);

subscription-related information inputting processing (subscription window, C. 10,

L. 26-28; Fig. 1, item 130);

subscription-related information processing (C. 10, L. 26-28).

Furthermore, Furst teaches producing conversion information based on the

registered contents provider information (C. 10, L. 26-28; Fig. 1, item 140); collecting a

history of preceding simplified or actual URLs requests (C. 7, L. 6), and providing

services on a subscription bases (subscription window) (C. 10, L. 26-28), thereby

suggesting charging customers for services rendered.

However, Furst does not specifically teach charging conversion fee based on

both the registered contents provider information stored in said contents registered

database and use history information registered.

Yates et al. teach a system and method for service provision by means of

communications networks, wherein usage history and associated accrued charges for

services rendered are monitored (C. 19, L. 49-53).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify Furst to include charging fee for services rendered, as

disclosed in Yates et al., because it would advantageously allow the business to collect

revenue. And it would have been obvious to one having ordinary skill in the art at the

time the invention was made to modify Furst in view of Yates et al. to include that said

conversion fee based on both the registered contents provider information stored in said

contents registered database (services rendered) and registered usage history, as

disclosed in Yates et al, because it would advantageously allow to provide discounts for

said subscriptions to the most frequent users thereby stimulating the users to increase

their usage time and profits to the system owners.

Claim 4. See reasoning applied to Claims 3 and 6.

Claims 5 and 7. Furst teaches, that in said conversion, said contents, when being

described in a foreign language, are translated into contents described in a native

language of a user (C. 11, L. 65-68).

Response to Arguments

Applicant's arguments filed 09/28/06 have been fully considered but they are

not persuasive.

In response to applicant's argument that Furst does not disclose or suggest a

"translation instructing banner including conversion implementing request information,"

it is noted that Furst does, in fact, teach said feature. Specifically, Furst teaches

contents providing processing in which a non-programmed translation instructing

banner (Fig. 1, item 116; C. 4, L. 40-41) including conversion implementing request

information is arranged (C. 11, L. 65-67).

In response to applicant's argument that Furst does not disclose or suggest that

a "conversion implementing request" included in the banner is transmitted to a server

(web site), it is noted that Furst explicitly teaches:

"A translation application tool translates a web page from its native language into
a default language or a language of the user's choice. The tool transmits the context
web page (or a link to the context web page) to a translation server, which produces a
results web page that is sent to a client tool window for display." (C. 11, L. 65 - C. 12, L.
3).

In response to applicant's argument that Furst does not disclose or suggest a

charging system or conversion fees, it is noted that Yates was applied for this feature.

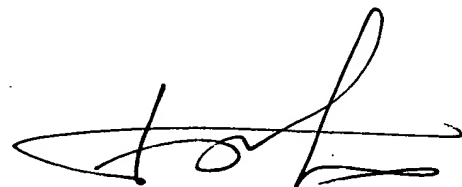Specifically, Yates et al. teach providing services by means of communications

networks, wherein usage history and associated accrued charges for services rendered

are monitored (C. 19, L. 49-53). The motivation to combine references would be

collecting revenue, as well as providing discounts for said subscriptions to the most

frequent users thereby stimulating the users to increase their usage time and profits to

the system owners.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Igor Borissov whose telephone number is 571-272-

6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR.   Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

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01/07/07

IGOR N. BORISSOV
PRIMARY EXAMINER